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Filing date: **06/03/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92061150
Party	Defendant Bigfoot Entertainment Inc.
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Attachments	64884-2 Reply Brief in Support of Motion To Dismiss 6-3-15.pdf(2463855 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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instances to establish one's standing to challenge a registered mark and the well-established doctrine of trademark "territoriality" as it pertains to the foreign domain name dispute now pending. Petitioner then essentially incorporates its "Counter-Statement of Facts" into its Amended Petition for Cancellation. It then proceeds to allege abandonment of the registered mark, not by Bigfoot Entertainment, Inc., owner of the registered mark as is necessary, but by Bell Media, Inc. the previous unrelated owner of the registered mark. On this point, Petitioner ignores the two essential elements of a claim for abandonment: allegations of non-use by the title owner of the registered mark, together with allegations of no intent by Respondent to resume use.

While Petitioner has certainly populated the docket with many documents and exhibits, a close examination of the Amended Petition for Cancellation again reveals Petitioner's failure to properly allege the factual basis for its standing, as well as Petitioner's failure to state a claim upon which relief can be granted. Unfortunately, this is not the first time Petitioner has failed to meet its important burdens considering its litigious pattern of behavior. As a consequence, Respondent questions whether Petitioner should be afforded any further opportunities to amend its petition.

In this connection, the Board should note that after two unsuccessful attempts to properly plead its declaratory judgment claims together with a motion to supplement its complaint in the pending federal district court case it brought in December 2014, Petitioner was given "one final opportunity to amend their complaint" by court order dated May 14, 2015. [See Exhibit A attached here to and Exhibit E (SIC – Civil Docket Sheet) to Petitioner's Memorandum in Opposition to Motion to Dismiss at Docket Entry: 1, 13, 56 and 79]. In that most recent court order, the court admonished Petitioner and cautioned plaintiffs "that they should carefully review

the elements they must plead for each of their claims” and that if “plaintiff includes claims ... to which there are obviously insufficient facts alleged, the Court will consider an appropriate and reasonable application for fees and costs ....” [Exhibit A at p. 2].<sup>1</sup>

In a similar vein, Petitioner filed another petition to cancel a registered mark owned by Fashion One Television, LLC, a sister company of Bigfoot Entertainment, Inc., but yet failed to prosecute the cancellation. As the Board will note in pending Cancellation No. 92058909, Petitioner failed to offer any evidence or take any testimony in support of that cancellation. Nor did Petitioner dispute the affirmative assertion that it was no more than an intermeddler in that case. Under the circumstances, Respondent fully appreciates that a party should be given every opportunity to plead its claims, but if those claims are essentially futile and/or the present petition is offered for no other reason than to perhaps harass Respondent, whose owner once had a former business relationship with Petitioner via other companies, then the petition should be dismissed. Dismissal is particularly appropriate in this instance where there are no set of facts upon which relief can be granted.

### **THE LAW**

The parties appear to be in general agreement about the legal standards to be applied. In order to withstand a motion to dismiss, the pleadings need only allege such facts as would, if proved, establish that (1) FTV has standing to maintain the proceeding, and (2) a valid ground for cancelling the incontestable registration now owned by Respondent. *Lipton Industries*,

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<sup>1</sup> In response to the court’s order, Petitioner filed its Second Amended Complaint in the pending civil action on May 28, 2015. Petitioner dropped its claims relating to false advertising, tortious interference, and trade libel, and now seeks a declaratory judgment action for non-infringement and a declaration that Registration No. 2945407 covering the mark FT/Fashion Television is “generic” and has been abandoned. These allegations are made despite Petitioner’s corresponding allegation in paragraph 45 that “Bigfoot has represented that it will seek to utilize the Mark, previously used in connection with a half-hour television program in the United States to operate a 24/7 television network.”

*Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well pleaded allegations must be accepted as true, and the complaint must be construed in a light most favorable to the plaintiff. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir.1999). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim. See *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters, Inc.*, 56 USPQ2d 1538 (TTAB 2000).

In appropriate cases, that is, where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity, for amendment. This is especially true, when, for example, the amendment would be futile because petitioner cannot prevail on its claim as a matter of law, or the amendment would serve no useful purpose. See e.g., *Institute National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998) and *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir.1984).

## **ARGUMENT**

### **1. The Amended Petition Should be Dismissed for Failure to Properly Allege the Factual Basis for Standing**

In the case at hand, Petitioner's Amended Petition for Cancellation should be dismissed because it still fails to properly allege the factual basis for its standing.

In unnumbered paragraphs 2 and 3 of the Preamble to the Amended Petition for Cancellation, and in paragraphs 11-13 of the Amended Petition, Petitioner sets forth the basis for its interest in the registered mark, and a purported rationale about "why" it is damaged by its continued existence. The gist of Petitioner's standing, as stated, is specifically the fact

Respondent has “(i) filed an action attacking Petitioner’s domain name www.fashiontv.com claiming that it is confusingly similar to the Mark; and (ii) caused cease-and-desist letters to be sent to Petitioner and its distributors alleging that Petitioner’s broadcasts are confusingly similar to the Mark, thus disrupting the marketplace and causing Petitioner to incur reputational and other damages.”

The fact there is a pending domain name dispute is of no factual or legal consequence. This is especially true when the domain name dispute is taking place in the World Intellectual Property Organization considering the principle of “territoriality” for trademarks. The domain name proceeding was filed in Europe and is based solely on Community Trademark Registration No. 599829, not U.S. Registration No. 2945407. [See Exhibit B]. There is no allegation that the domain name dispute even involves U.S. Registration No. 2945407 or even why it would. Thus, even if the allegation is true, this allegation does not allege how Petitioner is actually damaged in the United States by the continued existence of Registration No. 2945407. In keeping with the principle of trademark territoriality, the fact there may be a domain name pending in a foreign jurisdiction based on a Community Trademark, does not give Petitioner standing to challenge the rights Respondent has to the registered mark in the United States. “Under the territoriality doctrine, a trademark is recognized as having a separate existence in each sovereign territory in which it is registered or legally recognized as a mark.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, *supra* at § 29:1 (9/2012) [citations omitted]. The doctrine of territoriality of marks “is basic to American trademark law.” *Id.* [citations omitted].

The fact a licensee of Respondent sent a cease and desist letter also fails to garner the necessary damage to Petitioner. Indeed, if a petitioner’s only claim to “damage” from a registration consists of the fact that the registrant has “**threatened to**, or has in fact, filed an

infringement suit”<sup>2</sup> against the petitioner, this has not been regarded as sufficient “damage” to give standing to oppose an application or petition to cancel a registered mark similar to that involved in the civil infringement litigation. See *McCarthy on Trademarks and Unfair Competition*, § 20.12 [4] (p. 20-33 (6/2013)). The rationale for this general rule is the “inconsistent” positions the opposer or petitioner would be forced to assume. Simply put, an opposer or petitioner may be placed in the inconsistent position of defending a civil infringement action by asserting the defense of no likelihood of confusion on the one hand, and then on the other, asserting a likelihood of confusion to justify its standing in the cancellation.

Indeed, this is what has effectively happened in the present proceeding. After receiving the cease and desist letter from Respondent’s licensee, Petitioner initiated its declaratory judgment action in the matter styled *F.TV Ltd., and Fashion TV Programmgesellschaft MbH v. Bell Media, Inc. et al., and Bigfoot Entertainment, Inc. d/b/a Fashion Television International, Ltd.*, Civ. Action No. 14-cv-9856 (KBF) (S.D. N.Y.). In that action, Petitioner alleged claims for false advertising, tortious interference and trade libel, and also a declaration of non-infringement on the one hand, but, on the other hand, is now alleging that it is damaged by Respondent’s registration. Petitioner can’t have it both ways. Either it is damaged because the marks are confusingly similar and its claim for abandonment is justified, or, as Petitioner now alleges in its declaratory judgment action, there is no confusion or damage. This situation, of course, is in stark contrast to where the respondent in the cancellation proceeding is also the plaintiff in a pending infringement action against the petitioner. In those situations, there is now little question about the petitioner’s standing. However, such standing should not be readily recognized when it

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<sup>2</sup> Respondent acknowledges that recent law has found standing when there is, in fact, a civil action initiated by the respondent but not when petitioner initiates the action.. *Interim Inc. v. Interim Services, Inc.*, 1999 TTAB LEXIS 165 (TTAB 1999).

is the petitioner who “boots straps” itself into standing for the cancellation proceeding by bringing a declaratory judgment action for non-infringement and most recently for abandonment. See, e.g., *Interim Inc.*, *supra*.

Other than these two bases, there is no other predicate for Petitioner’s standing to cancel. With each basis for damage being insufficient, the Amended Petition for Cancellation should be dismissed for failure to properly allege the factual basis for its damage. Fear of the future or what one might possibly do based on a cease and desist letter, is far different from when a definite civil action has been instituted by the respondent. In *International Telephone and Telegraph Corporation v. International Mobile Machines Corporation*, 218 USPQ 1024 (TTAB 1983), for example, the Board was quite specific when it found that petitioner lacked standing when it alleged abandonment coupled with only a prospective belief that respondent’s registration might pose a potential bar in the future. Future possibilities of what might occur simply are not enough to traverse the inherently “low” threshold for standing.

In commenting about the CCPA’s decision in *Lipton*, Professor McCarthy noted that the threshold for standing is low, and is simply geared to weeding out the “intermeddler”:

But while the CCPA found that the facts of standing must be proven, it adopted a very liberal test for such standing. The court noted that the purpose of standing is simply to weed out “intermeddlers” from those with “a personal interest in the outcome beyond that of the general public.” *Lipton*, 213 USPQ at 188. A petitioner need only plead and prove “a real commercial interest in its own marks and a reasonable basis for its belief that it would be damaged.” McCarthy, *supra* at Section 20.13[1][a].

With the foregoing guidepost in mind, what then is Petitioner’s “reasonable factual basis” for its belief that it would be damaged by Respondent’s registration? If each basis asserted is in and of itself insufficient, what then is Petitioner’s basis? A cease and desist letter and/or a foreign domain dispute is clearly not enough under the law. On this point, Petitioner remains deafly silent. Petitioner remains silent because it is no more than an “intermeddler”. It did not



contest the affirmative “intermeddler” characterization in Cancellation No. 92058909, and its suspect motives in the present cancellation should now be openly questioned. While it is exceptionally rare for a person to incur legal fees and costs for no other purpose than to “harass” another, the Board should keep in mind that the parties in this proceeding are direct competitors and once enjoyed a working relationship with the other, though that business relationship has since, for the lack of a better term, “soured.”

**2. The Amended Petition for Cancellation should be Dismissed because it Fails to State a Claim Upon Which Relief can be Granted**

Under 15 U.S.C. Section 1127, trademark “abandonment” is defined to mean non-use of a mark, coupled with no intent by the owner to resume use of the mark. Under the law, three years of non-use is *prima facie* evidence of an intent to abandon the registered mark. This *prima facie* showing is subject to rebuttal by evidence showing an intent to resume use. “If an allegedly abandoned mark has been sold to another, the continued existence of goodwill may be proven by the fact the buyer was willing to pay a large sum for the mark .....” *McCarthy on Trademarks and Unfair Competition, supra*, § 17:14 (p. 17-32) (9/2012) citing *Sterling Brewers, Inc. v. Schenley Industries, Inc.*, 441 F.2d 675, 169 USPQ 590 (CCPA 1971).

Petitioner places a heavy emphasis on the Affidavit of Mr. Kevin A. Assaff, who is General Counsel to Bell Media, Inc., the previous owner of Registration No. 2945407. This Affidavit was extracted from the pending declaratory judgment proceeding initiated by Petitioner in the U.S. District Court for the Southern District of New York. [*F.TV Ltd and Fashion TV Programmgesellschaft mbH v. Bell Media, Inc. et al*, Civil Action No. 14-cv-9856 (KBF).] The Affidavit was filed by defendant Bell Media, Inc. in support of its Motion to Dismiss for Lack of Jurisdiction. By order dated May 14, 2015, Bell Media’s Motion to Dismiss Petitioner’s First Amended Complaint was granted. [See Exhibit C attached hereto].

In the Affidavit, Mr. Assaff recounts the long and successful history of both the Fashion Television series and channel – an international series that ran for over 27 years with syndication in Europe, the Pacific Rim and the United States before the show was, but for the Canadian market, cancelled in April 2012. Assaff Decl ¶14. Mr. Assaff also recounts the initial 2014 licensing arrangement with Respondent, Bigfoot Entertainment, and Respondent’s eventual December 24, 2014 purchase of all rights in and to the Fashion Television registered marks [other than rights in Canada], including Registration No. 2945407. The assignment transferring ownership of Registration No. 2945407 was recorded with the United States Patent and Trademark Office on February 17, 2015.

In the Amended Petition for Cancellation, Petitioner makes the following allegations for abandonment:

14. In April 2012, the FT Fashion Television Series, which had been broadcast on various cable channels in the US, was cancelled, and then-current owner Bell Media ceased use of the mark in the US.....

15. Bell Media abandoned the Mark with its final US use in April 2012. *Assaff Decl. 21.*

16. The Mark is not currently in use in the United States and has not been since April 2012.

17. The Registration should be cancelled because it has been abandoned.

18. According to Bell’s legal counsel, Bell Media had no intent of resuming use when it ceased broadcast of programming utilizing the Mark in April 2012. *Assaff Decl. 21.*

Even accepting each of these allegations as true, they do not state a claim upon which relief can be granted. At no point in the Amended Petition, does Petitioner ever allege abandonment by Bigfoot Entertainment, the current owner and recent purchaser of the mark. Petitioner has not made such allegations, because it knows that Respondent has every intention

to resume use of the mark in commerce with the United States. Why else would Respondent initially secure the licensing rights to the marks as stated by Mr. Assaff, and then shortly thereafter, execute its option to purchase the rights for four (4) million dollars? Recognizing a valuable brand and business opportunity, Bigfoot Entertainment seized the moment, and purchased the rights. The fact a television show might have been cancelled, does not in any way necessarily mean the branded property does not have “value” and “goodwill” and the possibility of “reintroduction” and/or “expansion” by a new owner. History is replete with such examples. One need only consider the Star Trek brand from its initial cancellation by NBC in the late 1960’s, to its successful resurrection and spin-offs since. More recently, the famed Hawaii 5 “0” television series from the early 1970s, was recently re-introduced. Even Petitioner recognizes this likelihood as evidenced by paragraph 45 of its Second Amended Complaint in the civil action, where it alleges that “Bigfoot has represented that it will seek to utilize the Mark, previously used ....”

Thus, when viewed in a light most favorable to Petitioner, there are no set of facts in this instance that can support Petitioner’s claim for abandonment. The very act of purchasing the rights to the mark in the United States for millions of dollars is clear evidence of an intent to resume use by the new owner and inherently refutes any *prima facie* showing of an intent to abandon the registered mark. At no point does Petitioner even allude to abandonment by Bigfoot Entertainment – only by Bell Media. This is not an inadvertent omission by Petitioner. Petitioner’s counsel is an experienced trademark practitioner, and properly pleads the elements of abandonment by Bell Media, but then artfully avoids the allegations as they relate to the new owner. The necessary allegations are avoided because Petitioner knows, by reason of their previous “working relationship,” that Bigfoot Entertainment has the resources and the intention

to resume use of this 27 year old brand. Any such allegations against Bigfoot Entertainment would prove futile, and perhaps be contrary to one's duties under Rule 11 of the Federal Rules of Civil Procedure.

### **CONCLUSION**

In so far as there are serious questions going to Petitioner's standing in filing the Amended Petition for Cancellation, and in so far as Petitioner fails to state a claim upon which relief can be granted, the Amended Petition should be dismissed. Nor does justice require the Board to permit further amendment. Facts and circumstances strongly suggest that Petitioner, as in co-pending Cancellation No. 92058909, is no more than an intermeddler, and that there are no state of facts to support abandonment of the registered mark by its new owner. To the extent any further leave to amend ultimately would prove futile, Respondent's Motion to Dismiss should be granted.

In view thereof, further action is respectfully solicited.

Respectfully submitted,

BIGFOOT ENTERTAINMENT, INC.

Date: June 3, 2015

/s/ Barth X. deRosa

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Jenny T. Slocum  
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*Counsel for Registrant/Defendant*

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing Motion to Dismiss under Rule 12(b)(6) for Lack of Standing by Petitioner is being forwarded this 3rd day of June, 2015 to counsel for Petitioner by email and first class mail, addressed to:

Raymond J. Dowd  
Dunnington Bartholow & Miller  
1359 Broadway, Ste. 600  
New York, NY 10018  
[rdowd@dunnington.com](mailto:rdowd@dunnington.com)

\_\_\_\_\_  
/s/ Barth X. deRosa

Barth X. deRosa

DC 64884-2 258029v2

# Exhibit A

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

USDC SDNY  
DOCUMENT  
ELECTRONICALLY FILED  
DOC #: \_\_\_\_\_  
DATE FILED: May 14, 2015

F.TV Ltd. and FASHION TV  
PROGRAMMGESELLSCHAFT MbH,

Plaintiffs,

-v-

BELL MEDIA INC., as successor-in-interest to  
CHUM LIMITED, and BIGFOOT  
ENTERTAINMENT, INC. d/b/a FASHION  
TELEVISION INTERNATIONAL, LTD.

Defendants.

14-cv-9856 (KBF)

ORDER

KATHERINE B. FORREST, District Judge:

The operative complaint in this action (the “First Amended Complaint”) was filed on January 21, 2015. (ECF No. 13.) Defendant Bell Media Inc. (“Bell”) has been dismissed in a separate Opinion & Order. The remaining claims of F. Tv Ltd. and Fashion TV Programmgesellschaft MbH (together, “FTV”) are against Bigfoot Entertainment, Inc. d/b/a Fashion Television International, Ltd. (“Bigfoot”) for false advertising, tortious interference, declaratory judgment “that plaintiffs’ broadcasts do not violate the Lanham Act,” declaratory judgment that Bigfoot is bound by this Court’s prior decisions in the Chum litigation,<sup>1</sup> and trade libel. Bigfoot has moved to dismiss the operative complaint, and FTV has cross-moved to “supplement” its allegations and for judgment on the pleadings as to its claims for declaratory relief.

<sup>1</sup> Chum Ltd. v. Lisowski, 198 F. Supp. 2d 530 (S.D.N.Y. 2002).

These motions follow several months of discovery conducted by the parties in connection with various jurisdictional arguments resolved by the Court's separate Opinion & Order dismissing FTV's claims against Bell. There were a number of facts developed during that discovery process that are outside of the four corners of the pleadings. In particular, one of Bigfoot's principal arguments is that the First Amended Complaint does not allege sufficient facts to support an inference that it is responsible for the actions of "FTIL." In response, plaintiffs have cited to evidence developed during the discovery program.

In light of the mismatch between the First Amended Complaint and the record on this motion, the Court will allow plaintiffs one final opportunity to amend their complaint. Any amendment may not include Bell as a party, as the Court has dismissed Bell and does not intend to reconsider that decision.

In connection with any amendment, the Court cautions plaintiffs that they should carefully review the elements they must plead for each of their claims. It may well be that the only claim that may even potentially be brought at this time is for declaratory judgment of non-infringement. (The Court is not offering any view as to the merits of such a claim.) The remaining claims may require additional facts that do not appear to the Court to be present. If plaintiff includes claims in any amendment as to which there are obviously insufficient facts alleged, the Court will consider an appropriate and reasonable application for fees and costs incurred in connection with defendant having to address them.



Plaintiffs must serve and file any second amended complaint within **14 days**.

The Court will not extend that date.

In light of the Court's determination as set forth herein, the motions at ECF Nos. 24 and 55 are DENIED as moot.

The Clerk of Court is directed to close the motions at ECF Nos. 24 and 55.

SO ORDERED.

Dated: New York, New York  
May 14, 2015

A handwritten signature in black ink, appearing to read "K. B. Forrest", is written above a horizontal line.

KATHERINE B. FORREST  
United States District Judge

# Exhibit B

## **COMPLAINT TRANSMITTAL COVERSHEET**

Attached is a Complaint that has been filed against you with the World Intellectual Property Organization (**WIPO**) Arbitration and Mediation Center (the **Center**) pursuant to the Uniform Domain Name Dispute Resolution Policy (the **Policy**) approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**) approved by ICANN on October 30, 2009, and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

The Policy is incorporated by reference into your Registration Agreement with the Registrar(s) of your domain name(s), in accordance with which you are required to submit to a mandatory administrative proceeding in the event that a third party (a **Complainant**) submits a complaint to a dispute resolution service provider, such as the Center, concerning a domain name that you have registered. You will find the name and contact details of the Complainant, as well as the domain name(s) that is/are the subject of the Complaint in the document that accompanies this Coversheet.

You have no duty to submit a Response to the Complaint until you have been formally Notified of the Complaint and Commencement of Administrative Proceedings by the Center. Once the Center has checked the Complaint to determine that it satisfies the formal requirements of the Policy, the Rules and the Supplemental Rules, it will forward an official copy of the Complaint, including annexes, to you by e-mail as well as sending you hardcopy Written Notice by post and/or facsimile, as the case may be. You will then have 20 calendar days from the date of Commencement within which to submit a Response to the Complaint in accordance with the Rules and Supplemental Rules to the Center and the Complainant. You may represent yourself or seek the assistance of legal counsel to represent you in the administrative proceeding.

- The **Policy** can be found at <http://www.icann.org/en/dndr/udrp/policy.htm>
- The **Rules** can be found at <http://www.icann.org/en/dndr/udrp/uniform-rules.htm>
- The **Supplemental Rules**, as well as other information concerning the resolution of domain name disputes can be found at <http://www.wipo.int/amc/en/domains/supplemental/eudrp/>
- A **model Response** can be found at <http://www.wipo.int/amc/en/domains/respondent/index.html>

Alternatively, you may contact the Center to obtain any of the above documents. The Center can be contacted in Geneva, Switzerland by telephone at +41 22 338 8247, by fax at +41 22 740 3700 or by e-mail at [domain.disputes@wipo.int](mailto:domain.disputes@wipo.int).

You are kindly requested to contact the Center to provide an alternate e-mail address to which you would like (a) the Complaint, including Annexes and (b) other communications in the administrative proceeding to be sent.

A copy of this Complaint has also been sent to the Registrar(s) with which the domain name(s) that is/are the subject of the Complaint is/are registered.

By submitting this Complaint to the Center the Complainant hereby agrees to abide and be bound by the provisions of the Policy, Rules and Supplemental Rules.

*Before the:*

**WORLD INTELLECTUAL PROPERTY ORGANIZATION  
ARBITRATION AND MEDIATION CENTER**

**Fashion Television International Limited**  
20-22 Wenlock Road  
London N1 7GU  
Great Britain

**(Complainant)**

-v-

**fashiontv.com GmbH**  
Brienner Str. 21  
80333 Munich  
Germany

**(Respondent)**

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**Disputed Domain Name:**

**<fashiontv.com>**

**COMPLAINT**

(Rules, Paragraph 3(b); Supplemental Rules, Paragraphs 4(a), 12(a), Annex E)

**I. Introduction**

[1.] This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 30, 2009, and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

## **II. The Parties**

### **A. The Complainant**

(Rules, Paragraphs 3(b)(ii) and (iii))

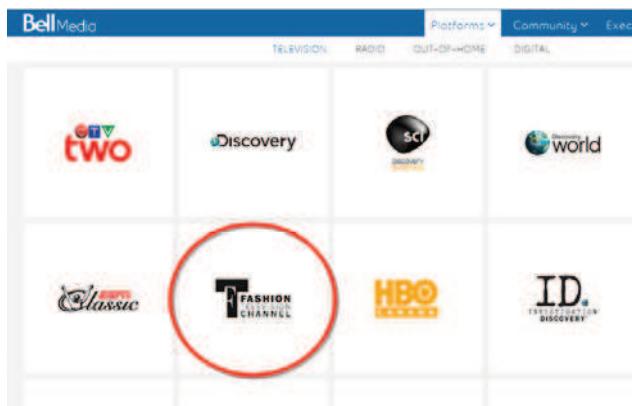
[2.] The Complainant in this administrative proceeding is **Fashion Television International Limited**, 20-22 Wenlock Road, London N1 7GU, Great Britain.

#### **aa. The Complainant and the Program FASHION TELEVISION**

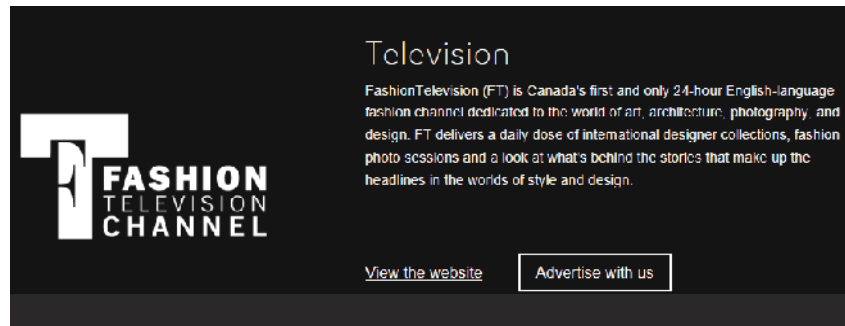
The complainant is a (sub-) licensee of Community Trademark Registration No. 599 829 FASHION TELEVISION (& device) which is the basis for this complaint (for more information, please see clause VII. A. below). The Complainant is entitled by the trademark owner, Bell Media Inc. (hereinafter referred to as **Bell Media**), Canada, to claim rights resulting from Community Trademark Registration No. 599 829 FASHION TELEVISION (& device) in its own name. Corresponding documents could be submitted if the aforesaid is disputed.

Bell Media is a big Canadian undertaking within the media business. It is part of the Bell Canada group. Bell Media produces and broadcasts up-to-date television programs and – shows, including 35 specialized thematic channels such as the program FASHION TELEVISION. Bell Media operates a corresponding large network of radio and TV channels.

As mentioned above, one of the approximately 35 specialized thematic channels is the program FASHION TELEVISION, according to the following screenshot, available via [www.bellmedia.ca](http://www.bellmedia.ca):



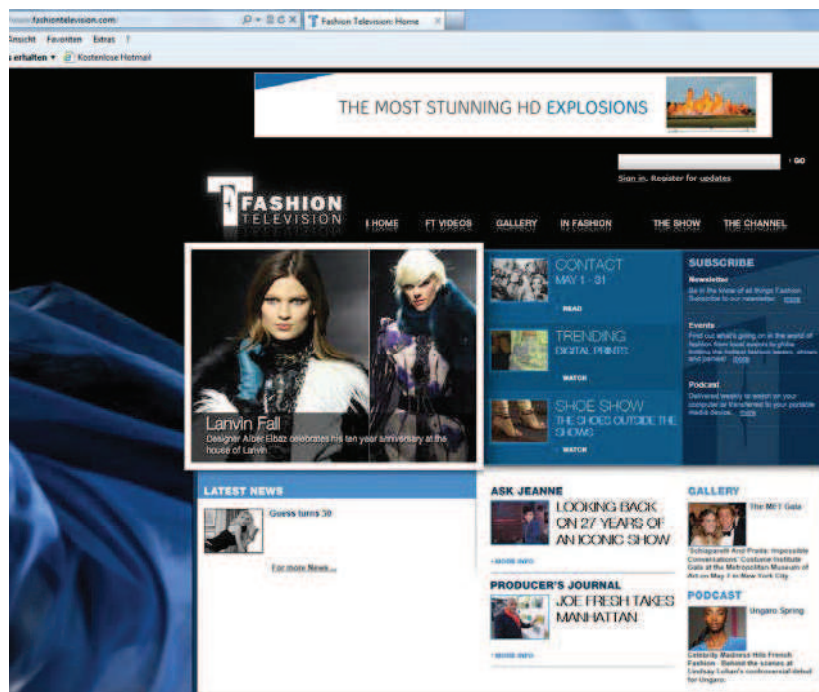
FASHION TELEVISION airs lifestyle related content with respect to the topics fashion, models, art, architecture and design as shown on the screenshot of the websites [www.bellmedia.ca](http://www.bellmedia.ca) below:



The main websites of the channel FASHION TELEVISION are available via

**[www.fashiontelevision.com](http://www.fashiontelevision.com).**

For the Office's ease of reference a corresponding screenshot of [www.fashiontelevision.com](http://www.fashiontelevision.com) is depicted below:



As per today, the domain <fashiontelevision.com> is registered in the name of Bell Media and was registered already on 25.05.1998, see

- Annex 1 -

## **bb. Background and Corporate History of the Channel FASHION TELEVISION Owners**

Initially, FASHION TELEVISION was produced and broadcasted by the CHUM Corporation.

On 14.01.2000 CHUM was given a broadcasting license (No. CRTC 2000-452) for the program FASHION TELEVISION; see

- Annex 2 -

On 07.03.2001, the Corporation was incorporated by Articles of Incorporation pursuant to the Business Corporations Act (Ontario) under the name CHUMCITY International Corp., registered under Ontario corp. #1466668. Only on 07.09.2006, CHUMCITY started broadcasting of FASHION TELEVISION according to the online article “History of CHUM” of [www.friends.ca](http://www.friends.ca) dated 12.07.2006, please see

- Annex 3 -

On 01.10.2003, CHUMCITY filed Articles of Amendment to change its name from CHUMCITY International Corp. to CHUM Television International Cor. (hereinafter referred to as **CHUM Television**).

On 21.07.2011, CHUM Television and Bell Media entered into a Distribution and Wind-Up Agreement whereby CHUM Television transferred all of its rights, assets, titles and interests to Bell Media. Immediately following the execution of the Distribution and Wind-UP Agreement, the CHUM Television filed Articles of Dissolution pursuant to the Business Corporations Act (Ontario) which resulted in the dissolution of CHUM Television as of 21.07.2011.

A corresponding statutory declaration regarding the corporate history as executed by Mr. Kevin A. Assaff, Corporate Secretary of Bell Media, dated 17.10.2014 is enclosed to this complaint as

- Annex 4 -

[3.] The Complainant's contact details are:

**Fashion Television International Limited**  
Address: 20-22 Wenlock Road  
London N1 7 GU  
United Kingdom

[4.] The Complainant's authorized representative in this administrative proceeding is:

Ms. Gwen Jayme  
20-22 Wenlock Road  
London N1 7 GU  
United Kingdom

[5.] The Complainant's preferred method of communications directed to the Complainant in this administrative proceeding is:

Electronic-only material  
Method: e-mail  
Address: gwen@fashiontelevision.com  
Contact: Gwen Jayme



**B. The Respondent**  
(Rules, Paragraph 3(b)(v))

- [6.] According to the databases “Whois” of the company TUCOWS, Inc., available via <http://www.tucowsdomains.com/whois> regarding the domain name <fashiontv.com>, Respondent in these proceedings is the German company **fashiontv.com GmbH**, Brienner Str. 21, 80333 Munich, Germany.

A corresponding excerpt of the aforesaid “Whois” databases, conducted on 20.03.2015 is enclosed as

- Annex 5 -

- [7.] All information known to the Complainant regarding how to contact the Respondent is as follows:

**fashiontv.com GmbH**

c/o Attttomey-at-law Mr. Jukbowicz

Brienner Str. 21

80333 Munich

Germany.

A corresponding excerpt from the German Companies’ Registry is enclosed as

- Annex 6 -

The Respondent is a dummy corporation which merely has a letter-box-company under the above referenced address in Munich, Germany.

The websites available via [www.fahsiontv.com](http://www.fahsiontv.com) are the main websites of the corresponding television channel FASHION TV of Fashion TV Programmgesellschaft mbH, Wasagasse 4, 1090 Vienna, Austria, and its founder, Mr. Michel Adam (Michel Adam is a pseudonym, the true name is Mr. “Adam Lisowski”).

Consequently, it is not surprising at all that administrator of the domain name <fashiontv.com> is a person called Mr. Gabriel Lisowski, apparently a relative of Mr. Adam Lisowski (supposedly his brother).

The television channel FASHION TV, respectively FASHIONTV also covers that topics related to the international fashion scene and lifestyle. Just like FASHION TELEVISION, FASHION TV broadcasts in English language.

### **III. The Domain Name(s) and Registrar(s)** (Rules, Paragraphs 3(b)(vi), (vii))

[8.] This dispute concerns the domain name identified below:

**<fashiontv.com> with a creation date of 15.03.1996.**

However, we would like to point out to the fact that the address of the Respondent together with attorney-at-law Mr. Jakubowicz as the registrant are firstly mentioned on **01.04.2007** according to a domain name search via “Domaintools” in

**- Annex 7 -**

(see page 7).

Annex 7 further shows, that the domain name <fashiontv.com> was registered in the name of various persons.

[9.] The registrar(s) with which the domain name(s) is/are registered is/are:

**Key-Systems GmbH**

Im Oberen Werk 1

66386 St. Ingbert

Germany

Phone: +49 (0) 68 94 – 93 96 850

Fax: + 49 (0) 68 94 – 93 96 851

Email: info@key-systems.net

CEO: Alexander Siffrin

Authorized signatories: Volker Greimann & Peggy Lücke

Register of companies: HR B 18835 - Saarbrücken

VAT ID number: DE 211 006 534

**IV. Language of Proceedings**  
(Rules, Paragraph 11)

- [10.] To the best of the Complainant's knowledge, the language of the Registration Agreement is English, a copy of which is provided as

**- Annex 8 -**

to this Complaint. The Complaint has been submitted in English.

**V. Jurisdictional Basis for the Administrative Proceeding**  
(Rules, Paragraphs 3(a), 3(b)(xv))

- [11.] This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The registration agreement, pursuant to which the domain name that is the subject of this Complaint is registered, incorporates the Policy (see clause 9.).

A true and correct copy of the domain name dispute policy that applies to the domain name in question is provided as

**-Annex 9 -**

to this Complaint and can be found at [https://www.icann.org/resources/pages/policy-2012-02-25-de?routing\\_type=path](https://www.icann.org/resources/pages/policy-2012-02-25-de?routing_type=path).

**VI. Factual and Legal Grounds**  
(Policy, Paragraphs 4(a), (b), (c); Rules, Paragraph 3)

[12.] This Complaint is based on the following grounds:

- A. The domain name(s) is(are) identical or confusingly similar to a trademark or service mark in which the Complainant has rights;**  
(Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

**aa. Trademark the Complaint is Based On**

Due to the above mentioned “Distribution and Wind-Up Agreement”, Bell Media is owner of Community Trademark Registration No. 599 829 FASHION TELEVISION (& device) (hereinafter referred to as **Trademark of Complaint**) which is registered with a priority of **11.08.1997** *inter alia* for the services

*“Television broadcasting services; telecommunications services; interactive electronic communications services; terrestrial broadcasting services; cable broadcasting services; satellite broadcasting services; production and distribution of television programs; providing information, education and entertainment services and the like via the media of television, satellite, telephone cable, audio, video, computer, electronic mail, the internet and other electronic media”*

in international classes 38 and 41.

An excerpt of the OHIM’s online databases regarding the Trademark of Complaint is enclosed as

- Annex 10 -

**bb. Use of the Mark FASHION ONE in Europe**

On 15.05.2014, Fashion TV Programmgesellschaft mbH, Vienna, Austria, filed a cancellation action based on non-use against the Trademark of Complaint with the OHIM.

However, it has to be explicitly pointed out that the Trademark of Complaint is *inter alia* used for the services

*“Television broadcasting services; satellite broadcasting services; production and distribution of television programs”.*

### **(1) Broadcasting in Scandinavia/Baltic Area and the Benelux via Nonstop Television**

As far as the Scandinavian/Baltic area is concerned, use of the mark FASHION ONE (& device) takes place by the television channel “Star! Scandinavia” of the Swedish company Nonstop Television 1.0 AB. “Star! Scandinavia” covers the broadcasting areas of Sweden, Denmark, Finland, Norway, Iceland, Lithuania, Estonia, Latvia, Belgium, the Netherlands and Luxemburg (see Schedule C of Annex 11 below).

According to

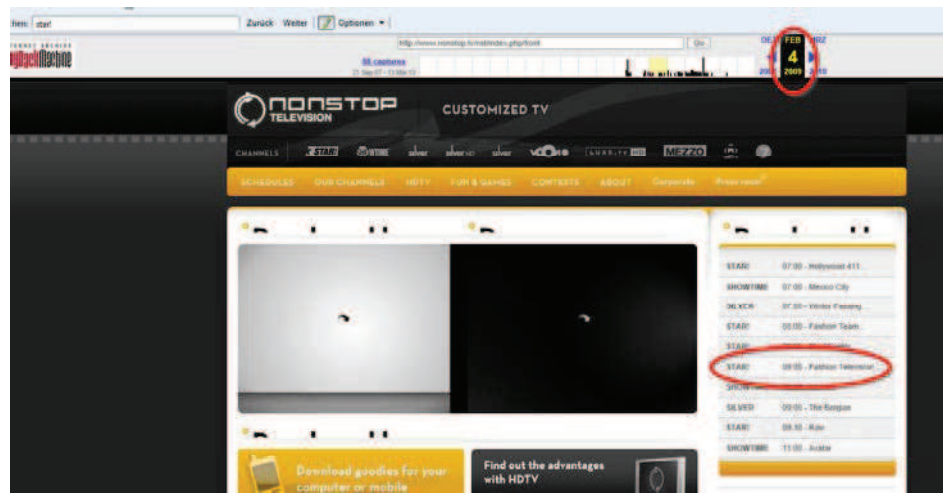
**- Annex 11 -**

Nonstop Television 1.0 AB has concluded a license agreement with CHUM TELEVISION (back then CHUMCITY) on 28.12.2003 already, which was replaced by the agreement of 01.10.2008 as submitted in Annex 11.

The fact that a licensing agreement existed in December 2003 shows that broadcasting within the Scandinavian, Baltic and Benelux area of the European Union was started early in 2004.

On that basis, FASHION TELEVISION is broadcasted on “Star! Scandinavia” until today within the area as outlined above.

As an example two announcements on [www.nonstop.tv](http://www.nonstop.tv) for such FASHION TELEVISION shows via “Star! Scandinavia” of 04.02.2009 and 02.11.2011 are depicted as follows:



As one can see from Schedule A of Annex 11, CHUM Television has delivered 43 episodes of FAHSION ONE between 01.01.2008 and 31.08.2009 with a total of 21,5 hours of broadcasting time. Between 01.09.2009 and 31.08.2010, 30 episodes of FASHION ONE covering 15 hours of broadcasting time have been delivered. The same counts with respect to the time period between 01.09.2010 until 31.08.2011 as well as 01.09.2011 until 31.08.2012. The delivered episodes were broadcasted via “Star! Scandinavia” repeatedly during the week within the aforementioned time frames.

The licensing agreement with Nonstop Television 1.0 AB is valid until today. Accordingly “Star!” airs FASHION ONE shows until today. In this context we would like to show the example of the broadcasting announcement regarding the episode titled “Victoria Bekcham’s Fashion Fantasy” on www.tv.nu for 21.11.2014:



## **(2) Broadcasting of FASHION TELEVISION by further Licensees within Europe**

According to the list of licensees for FASHION ONE episodes as submitted as

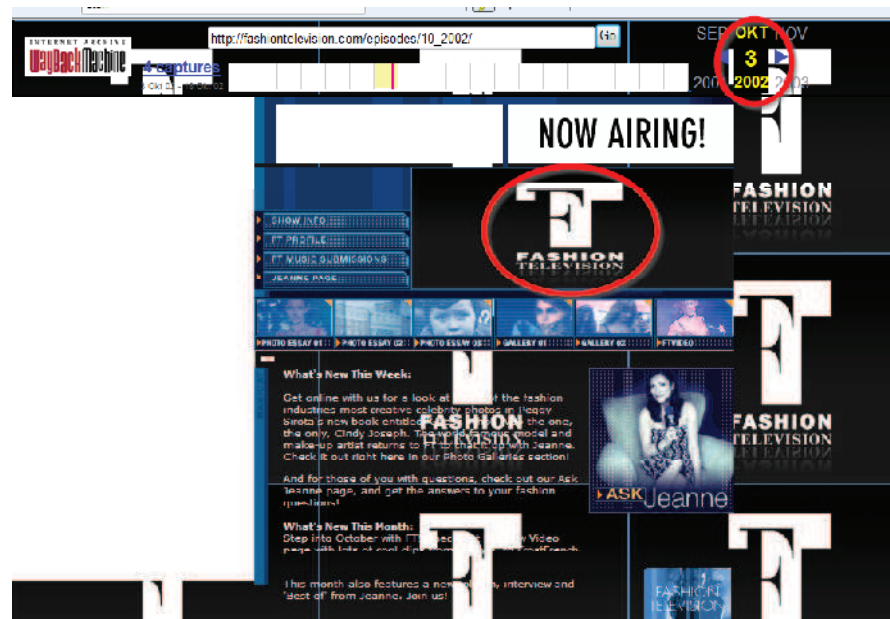
**- Attachment 12 -**

the FASHION TELEVISION episodes were also marketed and sold by various distribution partners within the different member states of the EU.

- Between 01.02.2007 and 31.01.2010, episodes 1U – 34U were marketed/sold in the Czech Republic and Slovakia by SPI Internaional by “free TV and cable/satellite.
- Via Vitaya TV, in Belgium and the Netherlands episodes 13-30 Season V were marketed between 01.04.2008 and 31.03.2010 via “cable & pay-tv, pa per video (PPV) and video on demand (VOD)”. Moreover, between 24.09.2008 and 13.09.2013 episodes 1 – 30 Season W were marketed/sold.
- Furthermore, regarding Poland, Hungary and Romania, the distribution partner Zone Club Channel respectively Romantica have marketed/sold episodes Season V, Season W and Season X between 01.04.2010 – 31.03. 2013 as well as between 01.10.2010 and 30.09.2013 via cable, satellite, DTT, VOD, free tv and PPV.
- In addition, the distribution partner Upsite Television has marketed/sold episodes Season X (2009/2010), Season Y (2010/2011) between 01.10.2010 – 30.09.2012 in France and Belgium.
- In Great Britain, the distribution partner Beyond Distribution has marketed/sold episodes Season Y and Season Z (2010/2011 and 2011/2012) between 01.09.2011 until 19.02.2012.

### (3) Broadcasting of FASHION TELEVISION via [www.fashiontelevision.com](http://www.fashiontelevision.com)

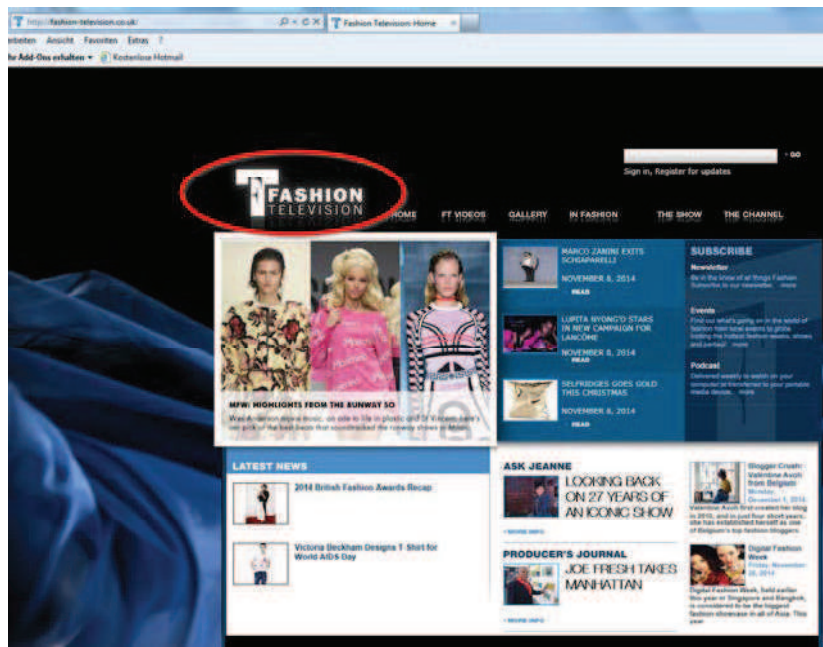
As indicated above, the FASHION ONE program is also aired via the main websites [www.fashiontelevision.com](http://www.fashiontelevision.com) worldwide according to usual practice in this branch of media. The below depicted screenshot of 02.10.2002 shows that the Trademark of Complaint was prominently used back then:



### (4) Broadcasting of FASHION TELEVISION via [www.fashiontelevision.co.uk](http://www.fashiontelevision.co.uk) in the UK

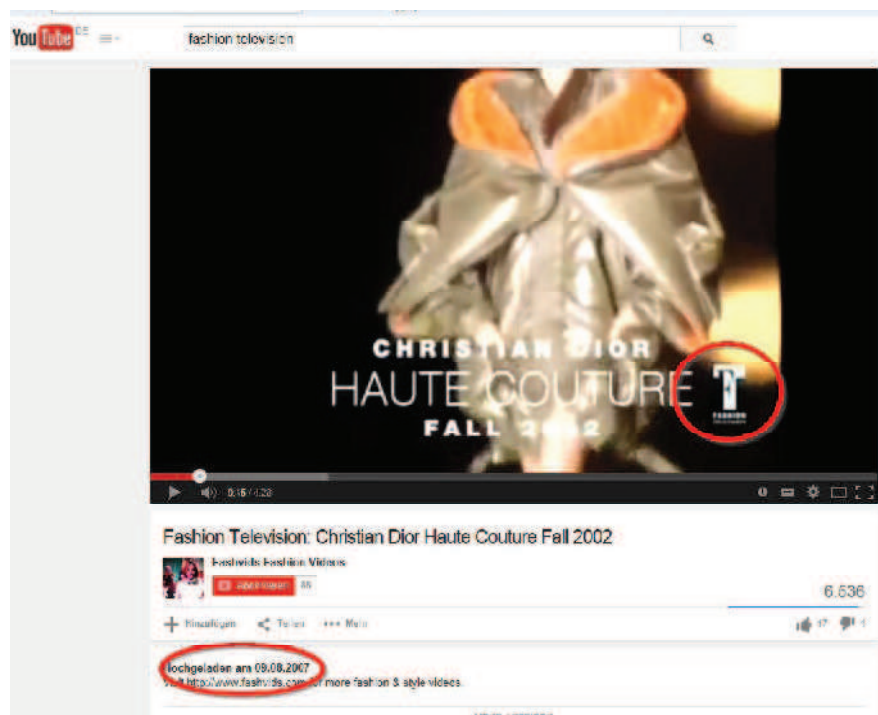
Besides the main websites [www.fashiontelevision.com](http://www.fashiontelevision.com), FASHION TELEVISION is also aired via national cc TLDs like for example the UK websites [www.fashiontelevision.co.uk](http://www.fashiontelevision.co.uk). A corresponding screenshot is shown below:





## (5) Broadcasting of FASHION TELEVISION via YOUTUBE

Moreover, FASHION ONE was broadcasted by an own YouTube channel. This is also common practice nowadays. As an example, we would like to show the below screenshot of a video broadcasted via the German YouTube sites YouTube(DE) which was uploaded on 09.08.2007. Said screenshot also prominently shows the Trademark of Complaint as the name of the specific program:



**cc. Likelihood of Confusion**

The domain name <fashiontv.com> is confusingly similar to the Trademark of Complaint, namely FASHION TELEVISION (& device).

Free of doubt, the consumers will recognize the element “tv” of <fashiontv.com> as an abbreviation or acronym for “television”. Therefore, both signs overlap identically from a conceptual consumer perception. Due to this identical overlap, consumer confusion cannot be excluded. Moreover, both signs overlap identically in the element FASHION. The conceptual identity is increased by the fact that the terms <fashiontv.com> and FASHION TELEVISION are nearly identical creations of words, namely FASHION + TV and FASHION + TELEVISION. This is a further aspect which leads to consumer confusion.

Moreover, it is clear that the consumers will perceive the element “.com” of <fashiontv.com> as being a descriptive element for Websites. Further, the figurative elements of the Trademark of Complaint will most likely only be perceived as decoration and not as an indication of origin. Also, with regard to the figurative elements, the principle applies that the consumers do not name any graphic elements when orally referring to a mark.

In light of the above, it has to be concluded that both signs are nearly identical and (*direct*) consumer confusion is expected.

In addition, it cannot be excluded that the consumers would confuse the signs *indirectly*. Theoretically, it is perceivable that the consumers might probably perceive the differences in the endings “TV” and “TELEVISION”. Nevertheless, the consumers might believe the Complainant and the Respondent are economically linked with each other for example by way of licensing agreements.

We would finally like to mention the decision *Disney Enters. Inc. v McSherry*, FA154589 (Nat. Arb. Forum June 17, 2003 <http://domains.adrforum.com/domains/decisions/154589.htm>). In the aforementioned decision the domain name <disneyvacationsvillas.com> was held to be confusingly similar with respect to the trademark DISNEY of the complainant as the trademark was identically included within the contested domain name. Consequently, the same must apply, here.

**B. The Respondent has no rights or legitimate interests in respect of the domain name(s);**  
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

Evidence has shown that the Respondent has registered the domain name <fashiontv.com> only on 01.04.2007.

By contrast, the complainant has started broadcasting of FASHION TELEVISION together with the use of the Trademark of Complaint FASHION TELEVISION (& device) early 2004 already. The Complainant has not authorized the Respondent to use its well-known trademark.

Respondent uses its websites <fashiontv.com> for commercial purposes in order to confuse the consumers about the trade origin of the relevant services. It is clear that Respondent wants to free ride on the economically success of the program FASHION TELEVISION and its corresponding websites [www.fashiontelevision.com](http://www.fashiontelevision.com) without any compensation. The FASHION TELEVISION program of the Complainant was known to the Respondent as they are competitors and before taking over the domain name <fashiontv.com> in April 2007.

Therefore, the Respondent has no rights or legitimate interest in respect of the domain name <fashiontv.com>.

C. **The domain name(s) was/were registered and is/are being used in bad faith.**  
(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

Respondent has solely acquired the domain name <fashiontv.com> in order to disrupt the Complainant in its economical efforts regarding the trademark FASHION TELEVISION (& device) and the corresponding websites www.fashiontelevision.com.

It is the Respondent's intention to attract for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's mark as to the source and endorsement of the Respondent's websites. The Respondent is using a nearly identical sign to the Trademark of Complaint in their domain name <fashiontv.com>.

**VII. Remedies Requested**  
(Rules, Paragraph 3(b)(x))

- [13.] In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section VI. above, the Complainant requests the Administrative Panel appointed in this administrative proceeding that the disputed domain name <fashiontv.com> be transferred to the Complainant.

**VIII. Administrative Panel**  
(Rules, Paragraph 3(b)(iv); Supplemental Rules, Paragraph 8(a))

- [14.] The Complainant elects to have the dispute decided by a "single-member Administrative Panel".

**IX. Mutual Jurisdiction**  
(Rules, Paragraph 3(b)(xiii))

- [15.] In accordance with Paragraph 3(b)(xiii) of the Rules, the Complainant will submit, with respect to any challenges that may be made by the Respondent to a decision by the Administrative Panel to transfer or cancel the domain name that is the subject of this Complaint, to the jurisdiction of the courts at the location of the domain name holder's address, as shown for the registration of the domain name(s) in the concerned registrar's WhoIs database at the time of the submission of the Complaint to the Center.

**X. Other Legal Proceedings**  
(Rules, Paragraph 3(b)(xi))

- [16.] There are no further legal proceedings pending relating to the domain name in dispute.

**XI. Communications**  
(Rules, Paragraphs 2(b), 3(b)(xii); Supplemental Rules, Paragraphs 3, 4, 12)

- [17.] A copy of this Complaint, together with the cover sheet as prescribed by the Supplemental Rules, has been sent or transmitted to the Respondent on 26 March 2015 by mail to the address as indicated above.
- [18.] A copy of this Complaint has been sent or transmitted to the concerned registrar(s) on 26 March 2015 by email.
- [19.] This Complaint is submitted to the Center in electronic form, including annexes, in the appropriate format.

## **XII. Payment**

(Rules, Paragraph 19; Supplemental Rules Paragraph 10, Annex D)

- [20.] As required by the Rules and Supplemental Rules, payment in the amount of USD 1,500 has been made by bank transfer to the WIPO's account:

WIPO / OMPI, 34 chemin des Colombettes, 1211 Geneva 20, Switzerland

IBAN: CH68 0483 5063 0397 8200 0

Swift Code: CRESCHZZ80A

Bank: Credit Suisse, 1211 Geneva 70, Switzerland

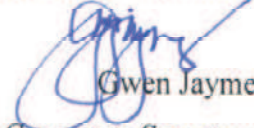
Subject: UDRP Bewscherde gegen <FASHIONTV.COM> ; Complainant: Fashion Television International Limited

## **XIII. Certification**

(Rules, Paragraph 3(b)(xiv); Supplemental Rules, Paragraph 14)

- [21.] The Complainant agrees that its claims and remedies concerning the registration of the domain name(s), the dispute, or the dispute's resolution shall be solely against the domain name holder and waives all such claims and remedies against (a) the WIPO Arbitration and Mediation Center and Panelists, except in the case of deliberate wrongdoing, (b) the concerned registrar(s), (c) the registry administrator, (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.
- [22.] The Complainant certifies that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,

  
Gwen Jayme  
Corporate Secretary

Date: March 26, 2015

#### **XIV. List of Annexes**

(Rules, Paragraph 3(b)(xv); Supplemental Rules, Paragraphs 4(a), 12(a), Annex E)

- Annex 1: Whois Tucows. Inc. regarding <fashiontelevision.com>
- Annex 2: Licensinig Agreement CHUM
- Annex 3: Online article “History of CHUM”
- Annex 4: Statutory Declaration Mr. Kevin A. Assaff
- Annex 5: Whois Tucows. Inc. regarding <fashiontv.com>
- Annex 6: Excerpt Companies’ Registry
- Annex 7: Copy “Domaintools”-Search
- Annex 8: Copy Registration Agreement Key-Systems GmbH
- Annex 9: Copy Rules icann.org
- Annex 10: Excerpt CTM FASHION TELEVISION (& device) from OHIM’s database
- Annex 11: Coy Licensing CHUMCITY and Nonstop Television
- Annex 12: List of licensees of FASHION TELEVISION

# Exhibit C



UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

USDC SDNY  
DOCUMENT  
ELECTRONICALLY FILED  
DOC #: \_\_\_\_\_  
DATE FILED: May 14, 2015

F.TV Ltd. and FASHION TV  
PROGRAMMGESELLSCHAFT MbH,

Plaintiffs,

-v-

BELL MEDIA INC., as successor-in-interest to  
CHUM LIMITED, and BIGFOOT  
ENTERTAINMENT, INC. d/b/a FASHION  
TELEVISION INTERNATIONAL, LTD.

Defendants.

14-cv-9856 (KBF)

OPINION & ORDER

KATHERINE B. FORREST, District Judge:

On December 12, 2014, F. Tv Ltd. and Fashion TV Programmgesellschaft MbH (together, “FTV”) commenced this lawsuit against Bell Media Inc. (“Bell”), as successor-in-interest to Chum Limited (“Chum”), and Bigfoot Entertainment, Inc. d/b/a Fashion Television International, Ltd. (“Bigfoot”).<sup>1</sup> Plaintiffs filed an amended complaint on January 21, 2015. (ECF No. 13 (“FAC”).) FTV seeks to hold defendants liable for false advertising, tortious interference, and trade libel and seeks a declaratory judgment with regard to its right to use the mark “Fashion Television.”

FTV’s lawsuit followed its receipt earlier that month of a cease and desist letter authorized by a subsidiary of Bigfoot, Fashion Television International, Ltd. (“FTIL”), relating to FTV’s use of certain marks in connection with programming

<sup>1</sup> Plaintiffs first named Bigfoot as a defendant in the First Amended Complaint. (ECF No. 13.)

broadcasts. According to FTV, its right to use the marks was resolved by litigation between 1998 and 2002—the results of which are binding on Bigfoot and FTIL.

Before this Court are motions to dismiss by both Bell and Bigfoot. (ECF Nos. 24, 28, 55.) This Opinion deals only with the motion by Bell. (ECF No. 28.) Bell has moved pursuant to rules 12(b)(2) and (6) on the bases that the Court lacks personal jurisdiction and for failure to state a claim. Bell’s motion is GRANTED.

## I. FACTUAL BACKGROUND

FTV is a television network that has been broadcasting fashion-related content since 1997. (FAC at 1.) In 1998, shortly before FTV launched in the United States, it was sued by Chum—Bell’s predecessor—for its use of the name “fashion television.” Chum v. Lisowski et al., 98 Civ. 5060 (KMW), 2001 WL 243541, at \*1 (S.D.N.Y. Mar. 12, 2001). Chum had used the Fashion Television mark in 1985 and commenced using it in the United States in 1992. Id. In that litigation, it was “undisputed that those of defendants’ marks that use the word ‘fashion’ in conjunction with TV or television ‘look [] similar’ to the [Chum] marks.” Id. at \*2 (first alteration in original). The Court granted summary judgment dismissing Chum’s trademark infringement and dilution claims but denied it as to a remaining unfair competition claim. Id. at \*7. In connection with its determination on summary judgment, the Court found that the mark “fashion television” was generic. Id. at \*8. Following a bench trial on that claim, judgment was entered in favor of FTV. Chum Ltd. v. Lisowski, 198 F. Supp. 2d 530, 542 (S.D.N.Y. 2002). No appeal was taken.

In 2006, defendant Bell acquired Chum. (FAC at 2.) In October 2014, Bell and Bigfoot entered into a letter of intent (“LOI”) pursuant to which Bigfoot would license the worldwide rights to a series of trademarks. (Declaration of Kevin A. Assaff, ECF No. 30 (Assaff Decl.) ex. B.) Bell and Bigfoot entered into a long-form license agreement effective as of December 24, 2014. (Declaration of Raymond J. Dowd, ECF No. 56 (“Dowd Decl.”) ex. I.) Pursuant to that agreement, in exchange for monetary payments totaling \$4 million, Bigfoot acquired Bell’s worldwide rights, excluding Canada, to a series of marks including “Fashion Television,” and logos using that name. (Dowd Decl. ex. I ¶ 4.1 & sched. D at BELLMEDIA000032-35.) Bell agreed that it would, if requested and in its sole discretion, assist Bigfoot with respect to any enforcement steps. (Dowd Decl. ex. I at ¶ 6.6.2.) Bigfoot agreed to indemnify Bell for costs associated with such assistance. (See id. ¶ 6.6.2.3.)

A. Jurisdictional Facts as to Bell

Bell is a Canadian media corporation with primary operations in Toronto, Ontario. (Assaff Decl. ¶¶ 2, 22-25.) It broadcasts programming in Canada and obtains advertising dollars in connection with such broadcasts from both Canadian and U.S. advertisers. (See Assaff Decl. ¶¶ 7, 24.) It does not have real property, offices, bank accounts or other assets in New York. (Supplemental Declaration of Kevin A. Assaff, ECF No. 65 (“Supp. Assaff Decl.”) ¶ 4.) It does not have any employees in New York. (Supp. Assaff Decl. ¶ 4.) It does not broadcast content or offer goods or services in New York. (Supp. Assaff Decl. ¶ 4.)

Bell’s contacts with New York are limited to the following: it is the successor-in-interest to Chum; and Chum initiated litigation against FTV in New York in

1998. (ECF No. 64 (“Bell Reply Br.”) at 5.) The securities of Bell’s ultimate parent, BCE Corporation, are listed on the New York Stock Exchange. (Bell Reply Br. at 5.) Bell uses TeleRep LLC (“TeleRep”), an independent media sales agency that sells advertising time to U.S. advertisers for U.S. and Canadian media clients, which has offices in New York. (Bell Reply Br. at 5.)

Bell is the owner of certain trademarks registered in the U.S. and elsewhere, and among its U.S. registered marks are the “FT Fashion Television” logo. (See Assaff Decl. ¶¶ 16-18, Declaration of Elizabeth A. McNamara, ECF No. 31 (“McNamara Decl.”) ¶ 13 & ex. 9.) The logo was registered in 2005 and became incontestable in 2010. (McNamara Decl. ¶¶ 13-14 & exs. 9-10.) This logo was not at issue in the Chum litigation. (See ECF No. 53 (“This use of a logo on a half-hour television episode is a different line of business from FTV’s, which is broadcasting an entire 24-7 channel. . . . Chum applied for the trademark registration in May 1996 and it was granted in 2005 . . . . Accordingly, Chum’s use of the logo was never inconsistent with FTV’s rights.” (citations omitted)).)

Bell licensed a variety of marks using the words “fashion television” or “Fashion TV” and associated logos to Bigfoot through two transactions: an initial assignment in the fall of 2014 and a final agreement in 2015. (Dowd Decl. ex. I sched. C; Assaff Decl. ex. F; Supp. Assaff Decl. ¶ 21.) One document bears a New York address for Bigfoot; and communications may have occurred between Bell in Canada and individuals representing Bigfoot in New York. (Dowd Decl. ex. I.) Invoices relating to the license agreement were sent to Bigfoot in New York. (Dowd

Decl. ex. K (“Assaff Tr.”) ll. 152:1-10.) While the extent to which the negotiations relating to the license agreement occurred in New York is disputed, the Court finds based on the record before it that the bulk were not in this District.

Bell has two sources of revenue arguably generated in or through New York: one-off content licenses and the acquisition of advertising time on Bell’s channels by U.S. companies that lack a Canadian presence. (Assaff Decl. ¶¶ 22-24.) These sources account for only a minute portion of Bell’s revenues. (Assaff Decl. ¶ 22.)

TeleRep, which sells advertising time on behalf of Bell to U.S. companies, is a separate company from Bell. (See Assaff Tr. ll. 49:15-24; Dowd Decl. ex. N (“TeleRep Aff.”) ¶¶ 1-3, 8 & ex. A.) TeleRep represents many U.S. media companies and broadcast stations and reached 90% of U.S. households, with total advertising sales in excess of \$2.8 billion dollars annually across 12 U.S. offices. (TeleRep Aff. ¶ 3.) TeleRep promotes more Canadian companies’ than just Bell; it accepts orders for Fashion TV as one of a group of properties, not by itself. (TeleRep Aff. ¶ 8.) TeleRep employs three salespeople in New York. (TeleRep Aff. ¶ 7.) None of TeleRep’s New York employees is an employee of Bell. (Supp. Assaff Decl. ¶ 8; see also Assaff Tr. at 188:24-189:9.)

Bell licenses content from U.S. companies for broadcast in Canada. (Assaff Decl. ¶ 24; Supp. Assaff Decl. ¶¶ 4, 13.) Of Bell’s most significant U.S. entertainment licensing arrangements, only two of those licensors are New York corporations: HBO and Comedy Central. (Supp. Assaff Decl. ¶ 16.) This is only a fraction of licensing fees paid by Bell to U.S. companies. (Supp. Assaff Decl. ¶ 16.)

## II. PERSONAL JURISDICTION OVER BELL

Plaintiff FTV bears the burden of demonstrating sufficient facts to justify a court's exercise of personal jurisdiction. Metro. Life Ins. Co. v. Robertson-Ceco Corp., 84 F.3d 560, 566 (2d Cir. 1996). Where, as here, the parties have engaged in jurisdictional discovery, the Court may look outside of the pleadings to determine jurisdiction has been demonstrated by a preponderance of the evidence. See Dorchester Fin. Sec., Inc. v. Banco BRJ, S.A., 722 F.3d 81, 86 (2d Cir. 2013). Conclusory assertions are insufficient. See S. New England Tel. Co. v. Global NAPS Inc., 624 F.3d 123, 138 (2d Cir. 2010).

Here, FTV has alleged both general and specific jurisdiction. The Court looks first to the law of the forum state (here, New York). Licci v. Lebanese Canadian Bank, SAL, 732 F.3d 161, 168 (2d Cir. 2013). If the Court finds that the provisions of the New York statute—the Civil Practice Law and Rules (“CPLR”)—have been met, the Court must then inquire into whether the exercise of personal jurisdiction comports with constitutional due process. Id.

### A. Specific Jurisdiction

#### 1. CPLR § 302(a).

CPLR § 302(a) governs the assertion of specific jurisdiction based on a non-domiciliary corporation's acts. N.Y. C.P.L.R. 302(a). It provides:

a. Acts which are the basis of jurisdiction. As to a cause of action arising from any of the acts enumerated in this section, a court may exercise personal jurisdiction over any non-domiciliary . . . who in person or through an agent:

1. transacts any business within the state or contracts anywhere to supply goods or services in the state; or
2. commits a tortious act within the state . . . ;  
or
3. commits a tortious act without the state causing injury to person or property within the state . . . if he
  - i. regularly does or solicits business, or engages in any other persistent course of conduct, or derives substantial revenue from goods used or consumed or services rendered, in the state, or
  - ii. expects or should reasonably expect the act to have consequences in the state . . .

The key to an assertion of personal jurisdiction pursuant to this section is a nexus between the act which gives rise to jurisdiction and plaintiff's cause of action. Chloe v. Queen Bee of Beverly Hills, LLC, 616 F.3d 158, 166-67 (2d Cir. 2010).

Once that nexus has been established, even a single act of contact with New York may be sufficient. Id. at 170. To determine whether this jurisdictional test has been met, a court must should examine the totality of the defendant's contacts with the forum state. Id. at 164.

Plaintiffs allege that specific jurisdiction over Bell pursuant to CPLR 302(a)(1) may be premised on the negotiations relating to the license agreement, on the October 2014 agreement between Bell and Bigfoot, the December 2014 license agreement into which they entered, or an agency relationship between Bell and Bigfoot that is alleged to have resulted in Bigfoot's causing its counsel to send the

cease and desist letter that was sent to FTV. Plaintiffs rely on the same conduct for their assertion of jurisdiction pursuant to CPLR 302(a)(3). None of this conduct supports jurisdiction as to Bell.

The Court has reviewed the record relating to the negotiations of the license agreement. There is no evidence that Bell spent any time in this District in meetings or negotiation sessions, nor is there any evidence that Bell executed the agreement in this District. Whether Bigfoot has an office in this District is in no way determinative of Bell's presence here. Similarly, even if Bigfoot had personnel in this District with whom Bell communicated (the facts as to which are contested), that is also in no way determinative. The Court finds that Bell was not actively negotiating the license in this District. The fact that invoices seeking payment pursuant to that agreement may have been sent to Bigfoot in this District is insufficient to support purposeful availment by Bell of New York as a forum.

The essential claim that underlies the remainder of each of plaintiff's jurisdictional arguments is that Bell and Bigfoot are acting in concert—that Bell is ultimately behind the cease and desist letters, or other efforts to assert rights over FTV to the “Fashion Television” mark. The evidence developed to date does not support this assertion. The evidence before the Court supports only that Bell and Bigfoot entered into an arms-length (\$4 million) license agreement, pursuant to which Bigfoot obtained whatever rights Bell may have had to the “Fashion Television” marks and logos in all jurisdictions except Canada. The evidence does not support an inference that Bell is in fact behind the cease and desist letters and



is using Bigfoot as its New York foil. All of plaintiffs' arguments in this regard are speculative.

The documentary and deposition evidence supports Bell's assertion that it is a Canadian company that licenses programming entirely unrelated to this litigation from certain U.S. (and New York) entities, sells advertising to its programming (that also has nothing to do with this lawsuit) through an agent based, inter alia, in New York. It is also the owner of a number of registered marks and has licensed certain marks to Bigfoot. None of this has any nexus to this case to support specific jurisdiction.

2. Due process.

In addition to finding a statutory basis for jurisdiction, a court must determine "whether the district court's exercise of personal jurisdiction over a foreign defendant comports with due process protections established under the United States Constitution." Licci, 732 F.3d at 168. To determine whether the Court's exercise of jurisdiction over a foreign defendant comports with due process protections, the Court considers first whether "a defendant purposefully established minimum contacts within the forum State," and second "whether the assertion of personal jurisdiction would comport with fair play and substantial justice"—that is, whether it would be reasonable. Burger King Corp. v. Rudzewicz, 471 U.S. 462, 476 (1985) (internal quotation marks omitted).

The Second Circuit has recited a five factor test for this "reasonableness" analysis: "(1) the burden that the exercise of jurisdiction will impose on the defendant; (2) the interests of the forum state in adjudicating the case; (3) the

plaintiff's interest in obtaining convenient and effective relief; (4) the interstate judicial system's interest in obtaining the most efficient resolution of the controversy; and (5) the shared interest of the states in furthering substantive social policies.” Chloe, 616 F.3d at 164-65 (citing Asahi Metal Indus. Co., Ltd. v. Superior Court of Cal., 480 U.S. 102, 113-14 (1987)).

Even if this Court were to determine that any of the above facts, or Chum's prior litigation with FTV—and the resulting judgment—satisfied CPLR § 302(a), it would nonetheless find that due process prevented the exercise of jurisdiction in these circumstances. The Second Circuit's factors are not met. The Chum litigation occurred over a decade ago—indeed, that action was commenced almost 18 years ago. That litigation was commenced by a predecessor entity to Bell and, while it is certainly the case that Bell is bound by the determination in that case, that is not the equivalent of requiring Bell to appear in this jurisdiction to the end of time in connection with any lawsuits relating to the Fashion Television mark or the FT Fashion Television logo. This is particularly so when all evidence supports that Bell has washed its hands of the marks through its license to Bigfoot. Bigfoot's rights are limited to those that Bell has—and Bigfoot cannot seek to enforce greater rights than those that Bell has. But that is a different legal and factual proposition from one which would require Bell itself to appear in this District every time a licensee chooses to try and enforce rights. FTV is fully entitled to use the Chum judgment as appropriate—but it must do so in this jurisdiction as against the licensee or assignee, not against Bell.

Thus, the record before this Court supports Bell’s claim that, as a Canadian company which does not regularly do business in New York, litigating here would be burdensome. In addition, there is no particular state interest in litigating a case here. No showing has been made that principles of collateral estoppel could not be applied in another forum. While plaintiffs do have an interest in obtaining relief in this District—thus meeting the third factor—that alone is not enough. Finally, interstate issues and social policies are not at issue in light of the residence of Bell and nature of the case.

B. General Jurisdiction

Plaintiff’s arguments with regard to general jurisdiction fare no better. General jurisdiction is broader than specific jurisdiction—it is the equivalent of a defendant being “at home” in a forum state. Goodyear Dunlop Tire Operations, S.A. v. Brown, 131 S.Ct. 2846, 2851 (2011). To support general jurisdiction, a defendant’s contacts must be continuous and systematic. Id. It is also possible that a court could have general but not specific jurisdiction over a defendant (for instance, in a situation in which conduct occurred outside of the forum but the defendant is at home in the forum). That, however is not the case here. Here, the facts developed during discovery leave no doubt that Bell is a foreign, non-domiciliary corporation. No facts support an inference—let alone a finding—that Bell is “at home” in New York.

In support of its assertion of general jurisdiction plaintiff argues that the efforts of Bell’s advertising rep, TeleRep, and other licensing efforts (e.g., of HBO programming) are so frequent and continuous as to make it “at home” in New York.

That is incorrect. While TeleRep is sells advertising time on behalf of Bell, it is not itself “Bell,” is it not a subsidiary or even an affiliate of Bell. Of course, in Daimler AG v. Bauman the Supreme Court stated that even in cases where a corporation has in-forum contacts that are in some sense continuous and systematic, jurisdiction may nevertheless well be unsupportable. 134 S. Ct. 746, 761 (2014). If this case related to a claim arising from advertising time that TeleRep had sold, the analysis might be different (and it would also be an analysis under CPLR 302, not CPLR 301). But it is not.

The same is true with regard to Bell’s licensing of certain U.S.- and particularly New York-based programming content. This case does not arise from or relate to such licensing. The mere licensing of content is insufficient to support the type of continuous and systematic contacts that underlie general jurisdiction. Even if it did, to assert such jurisdiction on such a basis would be so unusual as to offend due process.

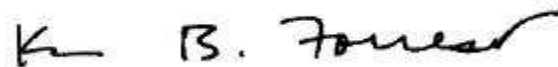
### III. CONCLUSION

For the reasons set forth above, Bell’s motion to dismiss is GRANTED.

The Clerk of Court is directed to close the motion at ECF No. 28.

SO ORDERED.

Dated: New York, New York  
May 14, 2015



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KATHERINE B. FORREST  
United States District Judge